

REMARKS

The Examiner is thanked for the comments in the Action. They have helped us considerably in understanding the Action and in drafting this Response thereto.

5 It is our understanding that claims 1-50 remain pending in this application, wherein claim 33 has been amended for reasons specifically remarked upon, below.

Preliminary item:

10 Claim 33 has been amended to clarify that the code segments of the computer program recited there are stored on a computer readable storage medium, in the manner already recited for claims 24-32. no new subject matter is added by this amendment.

Item 1 (§ 101 rejections of claims 1-50, all):

15 Claims 1-50 (all) are rejected as being directed to non-statutory subject matter.

Respectfully this is error.

As a preliminary point, the remarks in the Action are addressed to all of the claims, collectively, regardless of the fact that the claims encompass three different types of subject matter, and in some cases multiple major variations of such. Since one set of issues here is whether the subject matters are statutory it would appear that at least the respective types of 20 subject matters of the present claims have to be considered individually.

25 **Turning first to claims 1-21**, claims 1-9 recite “A method for disabling a virus in a computer” and claims 10-21 recite “A method for disabling a process in a computer.” The subject matters here each are a method, wherein “method” is generally accepted by the Office to be a synonym for “process.” The statute, 35 U.S.C. 101 (Inventions patentable), states “Whoever invents or discovers any new and useful process ... or any new and useful improvement thereof, may obtain a patent therefore” In view of this it cannot be seen from the record to date (i.e., the present Action) how the subject matters of claims 1-21 are not patentable.

Respectfully, it is the responsibility of the Office to make a *prima facie* case for rejection and that has not been done with respect to at least claims 1-21. For example, the Action states:

30 (*) [1] *Claims recite only perfunctory recitation of functional material (instance, object, computer, etc.).* [2] *Aside from this, the claims recite only*

nonfunctional descriptive material. [3] When nonfunctional descriptive material is recorded on some computer-readable medium ... (bracket references added)

With respect to [1] and [2], it clearly is error if these remarks were ever even intended to apply to claims 1-21. In these claims the recited functional steps include “indentifying” and

5 “storing” (independent claims 1 and 10), “editing” (claim 5), “monitoring” (claim 6), “rebooting” (claims 7 and 14), “determining” and “repeating” (claims 9 and 16), and “creating” and other “storing” (claim 17). None of these are a “perfunctory recitation of functional material (instance, object, computer, etc.).” None of the functional steps just noted here in claims 1-21 are even mentioned in the rejection and all of them contain more than mere perfunctory recitation.

10 For example, the storing step in claim 1 recites what is stored (an ACE), where it is stored (in an ACL for a system object), multiple characteristics of what is stored (the ACE specifies an entity and two distinct sets of permission criteria for that entity), etc.

With respect to [3], none of claims 1-21 recite a “computer-readable medium” and this and the rest to the remarks in the Action under the heading “CLAIM REJECTIONS” are clearly error, if these remarks were ever even intended to apply to these claims.

Accordingly, no *prima facie* case for the rejection of claims 1-21 has been made by the Office and these claims should now be allowable.

In the alternative, we note that “perfunctory recitation” is not part of any legal standard that appears to be applicable here. If we are mistaken and if this is felt to be a proper basis for 20 maintaining the rejections or for new ones, we request that the Office expressly cite authority for such in the statutes, rules, case law, or even in its own published procedures.

Turning next to claims 22 and 23, claim 22 recites “An article of manufacture made by the method of claim 1.” and claim 23 recites “An article of manufacture made by the method of 25 claim 10.” The subject matters here each are manufactures, specifically specially configured computers made as products by processes in which special steps have been performed. with respect to this, 35 U.S.C. 101 states “Whoever invents or discovers any new and useful ... manufacture ... or any new and useful improvement thereof, may obtain a patent therefore” In view of this it here as well cannot be seen from the record how the subject matters of claims 22-30 23 are not patentable.

With respect to the text from the Action quoted above at (*), all of our remarks about [1]-[3] apply equally here and we accordingly urge that no *prima facie* case for the rejection of

claims 22-23 has been made by the Office either and that these claims should now also be allowable.

Turning next to claims 42-50 (reserving discussion of claims 24-41 for last), these

5 recite “A system for disabling a process in a computer, comprising: means for identifying ...; and means for storing” The subject matter here is a system, wherein one of ordinary skill in the art will appreciate that “system” here is a synonym for “machine.” Relevant to this, 35 U.S.C. 101 states that “Whoever invents or discovers any new and useful ... machine ... or any new and useful improvement thereof, may obtain a patent therefore ...” and § 112 further states:

10 *... An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.*

15 In view of this it here as well cannot be seen from the record how the subject matter of claims 42-50 is not patentable.

With respect to the text from the Action quoted above at (*), all of our remarks about [1]-[3] generally apply equally here as well. For example, independent claim 42 recites a “means for identifying” and a “means for storing.” These are functional and have respective further 20 recitation that is much more than merely perfunctory, leaving any intended statement of a *prima facie* case for rejection here lacking as well (if this was ever even intended when drafting the Action). Similarly, claims 42-50 do not recite a “computer-readable medium,” thus clearly not being encompassed by the remarks in the Action related to such.

Accordingly we urge that no *prima facie* case for the rejection of claims 42-50 has been 25 made by the Office and that these claims should now also be allowable.

And turning now to claims 24-41, claims 24-32 recite “A computer program, embodied on a computer readable storage medium, for disabling a virus in a computer, comprising ...” claims 33-41 previously recites “A computer program for disabling a process in a computer, the 30 method comprising the steps of: ...” and claims 33-41 as herein amended now recite “A computer program, embodied on a computer readable storage medium, for disabling a process in a computer, comprising ...” The subject matters here are articles of manufacture, albeit now ones that do have elements present in a “computer-readable medium.”

As for whether articles of manufacture generally are patentable subject matter, we urge that our remarks elsewhere herein have clarified that such is the case. As for whether claims 24-41 have only “perfunctory recitation of functional material,” we urge that perfunctory recitation is not a basis under which the Office has the authority (i.e., one based on statute, rule, case law, or established procedure) to reject an applicant’s claims and we further urge that even if this were so that the claims at issue here include considerably more than mere perfunctory recitation. With respect to the latter point, these claims recite functional elements that include code segments that identify and store (independent claims 24 and 33), that edit (claim 28), that monitor (claim 29), that reboot (claims 30 and 37), that determine (claims 30 and 39), and that create and otherwise store (claim 40). None of these are a “perfunctory recitation of functional material (instance, object, computer, etc.).” None of the functional code segments here are even mentioned in the rejection and all of them contain more than mere perfunctory recitation. For example, claim 33 recites what is stored (an ACE), where it is stored (in an ACL for a system object), multiple characteristics of what is stored (the ACE specifies an entity and two distinct sets of permission criteria for that entity), etc.

With respect to claims 24-41 reciting a “computer-readable medium,” it is not nonfunctional descriptive material that is being embodied – in claims 24-41 it is functional descriptive material that is embodied in media. For example, in claim 24 the recited computer program comprises two code segments that perform specific functions, and it is these as part of the computer program that are then embodied on the computer readable storage medium.

The Action states “For further guidance on the term “nonfunctional”, please see MPEP 2106.” Applicant welcomes the guidance here of MPEP 2106 *et seq.* We note that § 2106 nowhere uses the term “nonfunctional,” but that § 2106.01 uses it repeatedly and states principles of the law that are directly on point here. For example, § 2106.01 states:

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. ... "Nonfunctional descriptive material" includes but is not limited to music, literary works, and a compilation or mere arrangement of data.

Both types of "descriptive material" are nonstatutory when claimed as descriptive material per se, When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of

technology permits the function of the descriptive material to be realized.
(underlining emphasis added)

Thus, § 2106.01 supports patentability of claims 24-41 here – at least, unless these claims are some kind of special case, and then the burden is on the Office to argue such as part of its

5 responsibility to make a *prima facie* case for rejection. The Office has not done this.

Respectfully, however, we urge that claims 24-41 here are not special cases in any manner that supports rejection here. Whereas § 2106.01 leaves open the possibility that some forms of functional descriptive material recorded on computer-readable mediums are nonstatutory, the MPEP guides us further here and due consideration of the particular subject matter in claims 24-

10 41 reveals that they are statutory. § 2106.02 states:

Claims to processes that do nothing more than solve mathematical problems or manipulate abstract ideas or concepts are complex to analyze and are addressed herein.

In practical terms, claims define nonstatutory processes if they:

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- *consist solely of mathematical operations without some claimed practical application (i.e., executing a "mathematical algorithm"); or*
- *simply manipulate abstract ideas ... without some claimed practical application.*

20 In the present case, claims 24-41 do more than perform solely mathematical operations or simply manipulate abstract ideas. Claims 24-32 recite code segments that disable a virus in a computer system and claims 33-41 recite code segments that disable a process in a computer.

Continuing, in the last paragraph on page 3 the Action discusses “claim limitations comprised of printed subject matter.” However, none of claims 1-50 recite anything related to 25 printing or printed subject matter. If this discussion in the Action is relevant to anything at issue here, we respectfully ask for an explanation of what that relevance is and then also for a reasonable opportunity to reply.

30 **Turning now to the “Subject Matter of presented Claims” section on page 4 of the Action,** this appears to includes statements that are contradictory and objectionable. This section starts, early on, by stating “Thus, any analysis on whether the prior art teaches claims 1-50 is a matter of currently irrelevant speculation. Nevertheless, the Office has analyzed claims 1-50 against the prior art.” We note that this appears to be consistent with the guidance in MPEP 707.07(g) to avoid piecemeal examination of applications. However, the last sentence of on page

4 of the Action then further states “One must note that not all claims meet the standards for patentability against the prior art.” This sentence contradicts the guidance against piecemeal examination and is totally unsupported in the record. There is no prior art discussed anywhere in the Action. In fact, the only art discussed in the Action is “post art,” being a White Paper by the

5 Applicant that was published two years after the present application was filed.

CONCLUSION

10 Applicant has endeavored to put this case into complete condition for allowance. It is thought that the §101 rejections are addressed by amendment or else shown to be unfounded under the rationale stated and have been completely rebutted. Applicant therefore asks that all objections and rejections now be withdrawn and that allowance of all claims presently in the case be granted.

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Respectfully Submitted,


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